

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/759,223

REMARKS

Applicant has added new dependent claims 15 (15/1), 16 (16/9) and 17 (17/10).

Applicant respectfully traverses the rejections of claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over WARDILL (GB '584) in view of SMITH ('898), and also respectfully traverses these rejections insofar as they may be applied to the new dependent claims 15, 16 and 17.

Applicant respectfully requests the examiner to reconsider and withdraw the rejections under 35 U.S.C. § 103(a) for the following reasons which explain why the examiner has not made out a *prima facie* case of obviousness with respect to the subject matter of each of claims 1-14 (and 15-17).

The examiner rejects independent claims 1, 9 and 10 under 35 USC 103 (a) based on the following conclusory statement/assertion:

*It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wardill to show the discrete regions being set-back regions defining notches open in the outer edge and the blocks extending through the notches because it would enhance the bonding of the molding to the body as taught by Smith.*

Applicant must respectfully disagree for the following reasons.

WARDILL discloses a load-bearing structure, for automotive vehicles, which comprises a metal body 4. Because of its intended use, this structure needs to be rigid and should not be flexible. The metal body 4 is fully embedded in plastic material. This is explicitly stated several times in WARDHILL, for example at page 2, line 23: page 3, line 48; and page 4, line 88. Due

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to this total embedment, the plastic material is fixed with respect to the metal body 4, despite the inefficient tensile properties of the bond between the plastic material and the metal body (see the passage bridging the two columns of page 2).

Therefore, this load-bearing structure does not need any further fixing means such as those claimed in the present patent application and those that the examiner (erroneously) alleged are found in SMITH.

SMITH discloses a trim strip for automotive vehicles which comprises a metal body 11 totally embedded in a plastic material 12 (see col. 2, l. 55). The metal body 11 is provided with weakening perforations so that it may be readily deflected (see col. 1, ll. 35-45 and ll. 60-62, and sentence bridging col. 2 and 3).

SMITH is silent regarding any bonding between the plastic material 12 and the metal body 11 provided by the perforations. This is not surprising since the bonding is not a concern, because the metal body 11 is totally embedded in the plastic material 12.

In any event, since SMITH is silent about bonding between the metal body 11 and the plastic material 12, SMITH totally lacks any suggestion or motivation to use notches to enhance the bond of the molding to a body.

What SMITH actually teaches is to provide a network of slots so that the metal body can easily be flexed and deformed. However, applying this teaching to the structure of WARDILL will destroy the intended function of this structure, since the structure, then, will be **unable to bear a load**.

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Therefore, the combination of WARDILL and SMITH is improper in that it clearly does not provide a *prima facie* case of obviousness of the subject matter of each of claims 1-14 (and 15-17).

In fact, as explained above, there is no proper motivation to combine these two references, and the examiner's assertion is purely based on prohibited hindsight reconstruction of the references, based on the Examiner's knowledge of Applicant's own disclosure.

Thus, for the reasons presented above, Applicant respectfully submits that the subject matter of each of independent claims 1, 9 and 10 would not have been (and could not have been) obvious to a person of ordinary skill in the art from a reading of the WARDILL and SMITH disclosures.

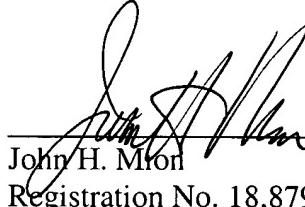
Therefore, Applicant respectfully requests the examiner to reconsider and withdraw the rejection of these independent claims 1, 9 and 10, and to allow these claims along with the dependent claims 2-8 and 11-17 which should be allowable both for depending on the allowable independent claims and also for the limitations added by these dependent claims. However, if for any reason the examiner feels that the application is not now in condition for allowance, the examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees

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under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,



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